

REMARKS

Claims 1-18 remain pending in this application. This response supplements the Amendment filed June 5, 2006.

The Office Action requires election of a species from the following: Species I, drawn to Fig. 1; Species II, drawn to Fig. 3; Species III, drawn to Fig. 4; Species IV, drawn to Fig. 5; Species V, drawn to Fig. 6; Species VI, drawn to Fig. 7.; Species VII, drawn to Fig. 8; or Species VIII, drawn to Fig. 9. Applicant herein traverses the restriction requirement asserted by the Examiner and hereby elects Species III directed to Fig. 4. Claims 2, 6 and 9-18 read on the embodiment shown in Fig. 4.

TRAVERSAL OF RESTRICTION OF SPECIES REQUIREMENT

Applicant traverses the restriction requirement as applied to Species I-VIII on two grounds. First, the restriction presented fails to properly state a case for restriction. Second, the species are so closely related that a search in either Species would essentially be identical and not present a serious burden on the Examiner.

A. Office Action does not satisfy requirements for setting forth a restriction requirement.

The MPEP specifically requires that, in making a restriction rejection requiring election of species, the Examiner state both reasons for distinctiveness and reasons establishing why examination of all claims would present a “serious burden”

on the Examiner. In particular, MPEP §808.01 (8th Ed., Rev. 5) states the following with regard to establishing distinctiveness:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

In making the present rejection it is respectfully submitted that the Examiner has not stated reasons for the distinctiveness of the species proposed by the Examiner. Hence, a mere conclusion is stated and a proper restriction is not set forth.

Still further, it is necessary that a serious burden on the Examiner be established. MPEP §808.01(a) specifically states:

A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required. See MPEP § 803 and § 808.02.

Where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

In the present invention claims, each recites a caulked portion having a given percentage of carbon and sulfur. Hence, a relationship is set forth. The Examiner has not stated any reasons why examination of all the claims present a serious burden on the Examiner. Therefore, a proper restriction has not been set forth in view of this deficiency in addition to the above noted lack of statement of reasons for the distinctiveness. As such, it is submitted that it would be improper to make

any Office Action issued in response to this reply final with regard to the restriction since applicant has not had the opportunity to reply to reasons necessary for the Examiner to make the restriction in the first place.

B. Claims pending do not present a serious burden to the Examiner and thus are not subject to restriction.

Applicant further submits that the present claims cannot be restricted because it cannot be established that they present a serious burden on the Examiner. This lack of burden is clearly established by the Examiner's present examination and rejection of each of the pending claims on the merits. Claims 1-4 and 7 were rejected as being anticipated and claims 1-8 were rejected on the basis of obviousness type double patenting. "If the search and examination of **>all the claims in an< application can be made without serious burden, the examiner must examine *>them< on the merits, even though **>they include< claims to independent or distinct inventions." MPEP §803 (8th Ed., Rev. 5) Hence, since the Office Action already presents substantive examination of the claims, consideration of all claims in the application cannot be said to present an undue burden since it is apparent the bulk of the work is already accomplished as evidenced by the present rejection. Clearly, prosecution of a divisional application resulting from the restriction would result in a duplication of effort by personnel of the Patent Office.

In view of the fact that the claims in question here have related subject matter and in view of the requirements set forth by the MPEP, reconsideration of the restriction requirement is respectfully requested and withdrawal of this restriction is respectfully requested.

Applicant is filing this response along with a PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR §1.137(b).

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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